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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,033	02/09/2005	Zdravko Paluncic	2004_1964A	4870
513 7590 07/24/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
RASHID, MAHBUBUR				
ART UNIT		PAPER NUMBER		
3683				
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07/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/524,033

**Applicant(s)**

PALUNCIC ET AL.

**Examiner**

MAHBUBUR RASHID

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-17 is/are pending in the application.  
4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 9-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 02/09/2005  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statements (IDS) were submitted on 02/09/2005. Accordingly, the examiner has considered the information disclosure statement, see attached 1449.

### ***Election/Restrictions***

Applicant's election of Species B, illustrated in Figures 2 and 2A in the reply filed on 04/15/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Drawings***

The drawings are objected to because a valve piston (1) featuring a bore (2) as disclosed in claim 9 is not clearly shown in figs. 2 and 2A. In figure 2, the reference number (2) is pointing at an element that appears to be the shaft of the valve piston (1) and not a bore. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered

and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

Claim 9 is objected to because of the following informalities: "Distributor element" in line 1 should be --A distributor element--. Appropriate correction is required.

Claim 9 is objected to because of the following informalities: "a return spring" in line 1 should be --a first return spring--. Appropriate correction is required.

Claim 13 is objected to because of the following informalities: in line 2, "any case" -- is not clear. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 recites the limitation "the lubricant volume" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 9, the phrase "may also be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 9-12** are rejected under 35 U.S.C. 102(b) as being anticipated by Smith, Sr. (US 3,664,462).

Regarding **claim 9**, Smith discloses a distributor (figs. 1-6) with a valve piston (41) featuring a bore (figs. 7-9, where the valve piston 41 is located), a lubricant inlet (52), a first return spring (64), a dispensing chamber (63), a metering chamber (54), a connecting passage (53), a passage (fig. 9, (55)), a dispensing piston (combination of 42 and 43), a second return spring (45) and a lubricant outlet (58)(please note that figs. 7-9 are viewing different positions of the lubricant entering the chambers or/and passages with the use of the pistons and springs as claimed).

**Re-claim 10**, see an essentially hollow cylindrical supporting body (38) between the return springs (64 and 45).

**Re-claim 11**, see the valve piston (41), the dispensing piston (combination of 42 and 43), the supporting body (38) and the two return springs (64 and 45) are arranged

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in a mutually axial configuration in a common passage (the entire inner space of (35) where the pistons (41 and 42) and springs (64 and 45) are located).

**Re-claim 12**, see the second return spring (45) surrounding the dispensing piston (combination of 42 and 43).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 13 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Sr. (US 3,664,462) in view of Conley et al. (US 2003/0089553 A1) or I. Cowles (US 1,652,764) or E. W. Davis (US 2,550,535).

Regarding **claims 13 and 14**, Smith discloses the first (64) and the second (45) return springs and the supporting body (38) as set forth above but fails to disclose that the second return spring surrounding the support body and the first return spring. Having such return spring surrounding a support body and another return spring is an engineering design choice; however, Conley, Cowles or Davis discloses a lubricating assembly with a second return spring (172 of Davis, 39 of Cowles or 79 of Conley) surrounding the support body (170 of Davis, 19 of Cowles or 120 of Conley) and a first return spring (168 of Davis, the small spring of Cowles or 77 of Conley). It would have been obvious to one of ordinary skill in the art at the time the invention was made to design the spring arrangement of Smith with the second return spring surrounding the support body and the first return spring as taught by Conley, Cowles or Davis, because such spring arrangement will provide steady and stable movement of the pistons during the operation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAHBUBUR RASHID whose telephone number is (571)272-7218. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mhr

/Robert A. Siconolfi/  
Supervisory Patent Examiner, Art  
Unit 3683